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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/966,298	09/27/2001	Dennis J. O'Rear	005950-657	5063

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EXAMINER

MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 02/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/966,298

Applicant(s)

O'REAR, DENNIS J.

Examiner

Ellen M McAvoy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/8/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-14 are still rejected under 35 U.S.C. 103(a) as being unpatentable over Berlowitz et al (6,080,301) or Berlowitz et al (6,165,949).

Applicant's amendments to the claim and arguments filed 24 November 2003 have been fully considered but the examiner maintains the position that the rejection of record over the Berlowitz et al ["Berlowitz"] references still applies. As set forth in the previous office action, the Berlowitz references disclose premium synthetic lubricating oil basestocks having a high viscosity index (VI) and low pour point which contain at least 95% by weight of non-cyclic isoparaffins. The lubricant basestocks are produced by hydroisomerizing waxy, Fischer-Tropsch synthesized hydrocarbons. See column 1, line 8, to column 2, line 14, of Berlowitz '301 and column 1, lines 5-65 and column 4, lines 23-28 of Berlowitz '949. The lubricant basestocks contain sulfur, nitrogen and metals in amounts of less than 1 ppm by weight. The examiner maintains the position that these premium synthetic basestocks clearly meet the limitation of component (a) of applicant's claims, that of at least one synthetic lube base oil having an isoparaffin content of greater than 50% and an Oxidator A value of less than about 1 which may be prepared by a Fischer Tropsch process. It is not clear how two seemingly identical synthetic base oils have different Oxidator A values. The lubricant basestocks of the Berlowitz references

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may be mixed or blended with one or more additional basestocks selected from the group consisting of (a) hydrocarbonaceous base stock which is a non-synthetic base stock, (b) a synthetic base stock, and mixtures thereof. Typical examples include base stocks derived from (i) poly-alpha-olefins, (ii) conventional mineral oils, (iii) mineral oil slack wax hydroisomerates, and mixtures thereof. See column 2, lines 25-44, and column 5, top, of Berlowitz '301 and column 5, lines 43-56 of Berlowitz '949. The examiner is of the position that when the one or more additional basestocks of Berlowitz is (a), a hydrocarbonaceous base stock which is a non-synthetic base stock, this meets the limitation of applicant's component (b). Although the Berlowitz references do not classify the additional blended basestocks in terms of Groups I-V, applicant teaches in the specification on page 5 that the majority of lube production is in the Group I category which designates lube base oils containing greater than 300 ppm sulfur, a saturate content of less than 90% and a viscosity index of between 80-120. And, as set forth in Berlowitz '301, by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil. Thus, the examiner maintains the position that the premium basestock blends of the Berlowitz references clearly meet the limitations of the lube base oil blends of the claims.

Initially the examiner emphasizes that it is appropriate for the applicant to bear the burden of proving that the seemingly identical or substantially identical compositions of the Berlowitz references do not actually possess the same Oxidator A and Oxidator BN values of the here claimed compositions. The fairness of such a burden allocation is evidenced by the inability of the Patent and Trademark Office to manufacture products or to obtain and compare prior art

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products. See In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977). As set forth previously, although the Berlowitz references do not describe the lube oil mixtures in terms of Oxidator A and Oxidator BN values, the examiner maintains the position that a clear line of distinction between the claimed invention and the lube oil blends of the prior art is not seen to exist because component (a), at least one synthetic lube base oil having an iso-paraffin content *greater than* about 50% (which includes values as high as 95%) of applicant's claims, and (b) at least one percent of a non-synthetic lube base oil of applicant's claims, may be the same as the compositions set forth in the Berlowitz references when the additional base stock is (a) a hydrocarbonaceous base stock which is a non-synthetic base stock. The examiner maintains the position that the Fischer-Tropsch derived oils set forth in Berlowitz may and most likely do also have an Oxidator A value of less than 1 but were not characterized as such. As set forth in applicant's co-pending application, Serial Number 09/882,709, page 1 and 2, "Although environmentally friendly, these Fischer-Tropsch [derived hydrocarbon] products tend to oxidize relatively rapidly when exposed to air. This rapid oxidation may be due to a lack of natural anti-oxidants such as sulfur compounds." And, as set forth in Berlowitz, premium synthetic lubricant base stocks of high purity may be derived from waxy Fischer-Tropsch hydrocarbons which contain contaminants such as sulfur, nitrogen and metals in amounts of less than 1 wppm; thus, lacking in any natural anti-oxidant compounds. See column 3, lines 58-64 of '301.

The Declaration under Rule 132 setting forth Oxidator BN values for various lubricating oils has been considered. As set forth in the previous office action, only 9 of the 38 oils tested have an Oxidator BN value less than 7 which is required by the claims. However, the additives

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in the basestocks have not been set forth and it would seem that the Oxidator BN value is dependent upon both the type and amount of additives. Presumably the same additive package has been added to the various base stocks to show a comparison of the different base stocks. In any event, Berlowitz also teaches fully formulated lubricating oils and, although not describing the oils in terms of an Oxidator BN value, the oils of Berlowitz may be the same (9/38 or 24% of the time) as the oils applicant requires for component (b) of the claims. Thus, the examiner maintains the position that it is not clear that the claims at issue differ from the possible oil compositions taught by Berlowitz.

Claim Rejections - 35 USC § 103

Claims 1-14 are also still rejected under 35 U.S.C. 103(a) as being unpatentable over Wittenbrink et al (6,332,974).

The amendments to the claims and arguments filed 24 November 2003 have been fully considered but the examiner maintains the position that the rejection of record over the Wittenbrink et al ["Wittenbrink"] still applies. As set forth in the previous office action, Wittenbrink disclose a wide-cut lubricant base stock having a low pour point and high viscosity index (VI) which is made by hydroisomerizing and then catalytically dewaxing a waxy Fischer-Tropsch synthesized hydrocarbon fraction. The base stock comprises at least 95% by weight of non-cyclic isoparaffins. See column 4, lines 5-38. The base stocks of Wittenbrink may also be blended with an additional lubricant base stock which may be selected from the group consisting of (i) a hydrocarbonaceous base stock, (ii) a synthetic base stock and mixtures thereof. See

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column 4, lines 33-50. Wittenbrink teaches that by "hydrocarbonaceous" it is meant a primarily hydrocarbon type base stock derived from a conventional mineral oil, shale oil, tar, coal liquefaction, and mineral oil derived slack wax. Thus the examiner maintains the position that Wittenbrink also clearly meets the limitations of the claimed lubricant base oil blends.

The arguments set forth above with regard to the Berlowitz references are incorporated herein. In summary, the examiner maintains the position that the Fischer-Tropsch derived oils set forth in Wittenbrink may and most likely do also have an Oxidator A value of less than 1 as does component (a) of applicants claims. Wittenbrink also teaches a blending base stock which may be (a) a hydrocarbonaceous non-synthetic base oil. Although not describing the oils in terms of an Oxidator BN value, the oils of Wittenbrink may be the same as the oils applicant requires for component (b) of the claims. Thus, the examiner maintains the position that it is not clear that the claims at issue differ from the possible oil compositions taught by Wittenbrink.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

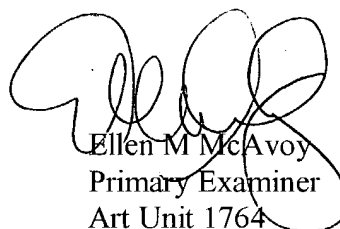
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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M McAvoy
Primary Examiner
Art Unit 1764

EMcAvoy
February 4, 2004